

REMARKS

SUMMARY OF TELEPHONE INTERVIEW

The applicant held a telephone interview with the examiner on 04/21/2009 to discuss the rejections in the current office action, and a proposed amendment. In particular, the applicant proposed to amend the claims by changing "at a predetermined time prior to the potential transmission time" to "proximate the potential transmission time". The examiner asserted this amendment would not distinguish over Emura in the event a user selected a program from the program guide proximate the transmission time.

The applicant then re-asserted that the combination of Emura and Ellis will not result in the invention recited in claim 3. In particular, if Emura were modified in view of Ellis, the resulting receiver would operate as taught by Ellis. That is, if a user were busy watching a particular channel at the transmission time of a selected program, and the user responds negatively to change the channel, then the receiver would simply not record the selected program as taught by Ellis (see figure 3b blocks 312 and 314).

REJECTION UNDER 35 USC § 103

The examiner rejected claims 1, 5 and 7-10 under 35 USC §103(a) as unpatentable over Schlarb (US 2004/0078823) in view of Mendelsohn (US 6,771,886), and further in view of Emura (US 6,344,878).

The applicant has amended claim 1 to include the limitations recited in claim 3.

The examiner rejected claims 3 and 4 under 35 USC §103(a) as unpatentable over Schlarb in view of Mendelsohn and Emura and further in view of Ellis (US 2005/0235323). The applicant respectfully disagrees.

Claim 3 covers an embodiment that illustrates an important distinction over Emura. In claim 3, a change channel request is displayed if the user is currently viewing a different channel at the time a program has been selected for recording. If the user responds positively to change the channel, then the status of the content delivery path is considered available. However, if the user responds negatively to change the channel, then the status of the content delivery path is considered not available and a different transmission time is selected for the program.

If Emura were modified in view of Ellis, the resulting receiver would operate as taught by Ellis. That is, if a user were busy watching a particular channel at the transmission time of a selected program, and the user responds negatively to change the channel, then the receiver would simply not record the selected program as taught by Ellis (see figure 3b blocks 312 and 314).

The teaching to select a different transmission time for a selected program if the user is busy watching a particular channel comes only from applicant's disclosure and not from Emura or Ellis. The rejection should therefore be withdrawn since applicant's disclosure cannot be used as prior art against his own claims. (In re Stencel 828 F.2d 751; 4 U.S.P.Q.2D (BNA) 1071 (1987)).

The examiner rejected claims 18-21 under 35 USC §103(a) as unpatentable over Russo (US 6,025,868) in view of Shah-Nazaroff (US 6,157,377) and further in view of Mendelsohn. The applicant requests these claims be canceled without prejudice.

The rejections of the remaining claims should be withdrawn for at least the reasons set forth above.

CONCLUSION

In view of the foregoing amendments and remarks, the applicant respectfully submits that the pending claims are now in condition for allowance and requests reconsideration of the rejections. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the examiner is invited to contact the undersigned attorney at the number listed below.

The Commissioner is hereby authorized to charge payment of any required fees associated with this Communication or credit any overpayment to Deposit Account No. 23-1209.

Respectfully submitted,

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